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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,224	12/22/2003	Tomohisa Sakurai	17324	7638
23389	7590	05/11/2005		
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER JOHNSON III, HENRY M	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/743,224	SAKURAI, TOMOHISA	
	Examiner Henry M Johnson, III	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) 5,14,23 and 24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>122203</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,068,627 to Orszulak et al. Orszulak et al. disclose an energy delivery device for use with surgical instruments including those using laser, microwave and ultrasonic energy, that includes means in a connector for identifying the specific surgical instrument attached by complementary optical elements in the receptacle and plug portions of the connector (Fig. 2). The method includes communicating the type of instrument connected by a cable between the first part and the instrument, by passing a signal of the modified invisible optical energy through the qualifying connection and to identifying circuit in the source of high frequency. A step of the

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method is assessing the modified invisible optical energy from the optical couplings with the identifying circuit for use as verification for controlling the source of high frequency energy (Col 6, line 67 to Col. 7, line 8). It is implicit that a plurality of instruments may be selected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,068,627 to Orszulak et al. in view of U.S. Patent 4,038,625 to Tompkins et al. Orszulak et al. disclose an energy delivery device for use with surgical instruments including those using laser, microwave and ultrasonic energy, that includes optical means in a connector for identifying the specific surgical instrument attached by complementary optical elements in the receptacle and plug portions of the connector (Fig. 2). The receptacle is interpreted as the first connector and the plug the second. While the invention cites the connectors on a cable and surgical instrument, the location of the connectors is considered a non-critical rearranging of parts. The optical elements communicate the type of instrument connected by a cable between the first part and the instrument, by passing a signal of modified invisible optical energy through the qualifying connection and to identifying circuit in the source of high frequency. The identifying information is stored in memory of the drive device (Col 6, lines 36-37). Orszulak et al. does not teach energy transmission and receiving in the connector portions. Tompkins et al. disclose an inductively coupled energy transfer connector using complementary transformer windings in portions of the connector (abstract). A treaded portion effectively "latches" the

connector sections together. Specific applications include medical electronics (Col. 1, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the inductively coupled connector as taught by Tompkins et al. in the surgical device of Orszulak et al. to provide a connector less sensitive to contamination.

Regarding claim 3, the end portion of the instrument (Fig. 1, # 13) is interpreted as a probe.

Claims 12, 13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,068,627 to Orszulak et al. in view of U.S. Patent 4,038,625 to Tompkins et al. as applied to claim 1 above and further in view of U.S. Patent Application Publication US 2002/0111621 to Wallace et al. Orszulak et al. and Tompkins et al. are discussed above, but do not disclose the use of a remote surgical arm. Remote surgical arms are well known in the art for endoscopic procedures as well as tele-surgical procedures. Wallace et al. teach a robotically controlled articulated arm for a surgical tool. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the robotic arm as taught by Wallace et al. in the invention of Orszulak et al. as modified by Tompkins et al. as the use of remote arms is pervasive in the art and therefore obvious to incorporate.

Allowable Subject Matter

Claims 5, 14 and 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication US 2004/0267297 to Malackowski teaches the use of RFID chips in a surgical device for providing positive identification of the instrument to the energizing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry M. Johnson, III
Primary Examiner
Art Unit 3739